

Appl. No. 09/823,117
Amdt. Dated August 12, 2004
Reply to Office Action of July 1, 2004

Docket No. TC00099
Customer Number 23330

REMARKS/ARGUMENTS

Claims 1-14 remain in the application. The actions taken are in the interest of expediting prosecution and with no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled in view of the prior art. Moreover, the amendment or cancellation of claims herein is without prejudice to pursuing claims of different scope by way of continuing Application. Reconsideration of this application is respectfully requested.

Objection to the Specification

The disclosure was objected to for failing to include a "Brief Summary of the Invention." It is stated in 37 CFR 1.73 that "a brief summary of the invention indicating its nature and substance, which *may* include a statement of the object of the invention, should precede the detailed description. Such summary should, *when set forth*, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed. The "Brief Summary of the Invention" is not a requirement in the specification and Applicants respectfully do not wish to set forth a summary.

35 U.S.C. § 103

Claims 1-5 and 8-12 are rejected under 35 U.S.C. § 103 as being unpatentable over Langseth et al. (U.S. Patent No. 6,694,316, hereinafter Langseth et al.) in view of Small et al. (U.S. Patent No. 5,642,303, hereinafter Small et al.). Claims 6-7 and 13-14 are rejected under 35 U.S.C. § 103 as being unpatentable over Langseth et al. in view of Small et al. in further view of Abbott et al. (U.S. Patent No. 6,513,046, hereinafter Abbott et al.).

Applicants' respectfully traverse the rejection and request reconsideration. It is incumbent upon the Examiner to prove a *prima facie* case of obviousness (MPEP 2143). To establish a *prima facie* case three basic criteria must be met. First, the prior art reference must teach or suggest all the claim limitations. Second, there must be a reasonable expectation of success. Finally, there must be some suggestion or motivation, either in the references

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themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference.

TRAVERSE (i): The combination does not provide Applicants' claimed invention.

Applicant's independent claims 1 and 12, call for, among other things, receiving a plurality of categorized content, evaluating each of the categorized content, assigning contextual audio content to each of the categorized content, and previewing the categorized content utilizing the contextual audio content.

Langseth et al. teaches a client apparatus, a system and method for providing a plurality of channels of content to enable subscribers to more specifically choose content they desire to receive (column 3, lines 13-16). Subscribers sign up to receive personalized output from one or more services over the channels. Subscribers may sign up to receive the services through a web interface that identifies each of the *available types* of information that the user may access (column 4, lines 22-38). Contrary to the assertion of the Examiner, the user is not previewing actual categorized content, but merely previewing the *type* of content available for ordering.

Small et al. teaches a system of providing a location based computer system that can remind users and provide location based computing functionality (column 2, lines 37-42). The system includes one or more beacons transmitting a unique beacon signal, with each beacon being placed in a user-desired location, and a portable receiver and computing host to inform the user of which location he is in based on the beacon signal (column 2, lines 43-55). Also, the beacon signal can prompt the computer host to remind the user of various tasks, such as printing of documents, charging of the computer, etc. The audio cues to these ordinary or user-generated tasks can be contextual (column 10, lines 16-28). However, Small et al. does not teach that these audio cues are related to categorized content of any kind, but merely to tasks performed by the computer or tasks that can be performed by the computer based on its location (as prompted by the beacon signal). In fact, Small et al. does not teach or suggest categorized content, let alone tying categorized content to contextual audio content.

Neither Langseth et al. nor Small et al. teach or suggest evaluating categorized content in order to assign contextual audio content to each of categorized content, and previewing the categorized content utilizing the contextual audio content. Langseth et al. merely teaches a series of channels that a subscriber can select from to receive certain *types* of content. The user reviews the types of content and selects the general *type* of content *so that specific content can*

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be received later. The user does NOT review or preview the content itself, but merely the general type of content available, where the actual content can be sent later. The general category of content previewed by a user in Langseth et al. in advance is not the same as the actual categorized content received as claimed by Applicants. Contrary to assertions by the Examiner, the audio cues taught in Small et al. that relate to location based computing and the capabilities available in a particular location, *do not* preview categorized content using contextual audio content. Small et al. merely reminds the user of applications or functions available to a remote computing device based on its location per a signal received from a beacon.

Abbott et al. teaches a system for computer-based storing of information about a current state. Abbott et al. does not make up for the deficiencies of Langseth et al. and Small et al.

Since either Langseth et al, Small et al. or Abbott et al. teach or suggest the above features of independent claims 1 and 8, they do not include all of the elements of Applicants' independent claims 1 and 8. Therefore, the combination cannot make obvious the Applicants' claimed invention.

TRAVERSE (ii): There is no motivation or suggestion contained in the cited art to combine the teachings of the references.

Before obviousness may be established, the Office Action *must show specifically* the principle, known to one of ordinary skill that suggests the claimed combination. In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). In other words, the Examiner *must explain* the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention. Id. The factual question of motivation is material to patentability and *cannot be resolved based on subjective belief and unknown authority.* Id. at 1344. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577 (Fed. Cir. 1984). The critical inquiry is whether there is something in the prior art as a whole *to suggest* the desirability, and thus the obviousness, of making the combination. Fromson v. Advance Offset Plate, 755 F.2d 1549, 1556 (Fed. Cir. 1985).

Langseth teaches delivering a plurality of personalized channels to a user. Small et al. teaches location based computing. Clearly, Langseth et al. and Small et al. are not in the same

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field of art and do not, within either document, provide a suggestion or incentive to be combined with each other. *The Office Action fails to show either a suggestion in the art or a compelling motivation based on sound scientific principles to combine the references and therefore the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn.* Applicants respectfully submit that there is no suggestion to combine the references, and if they could be properly combined, do not lead to the Applicants' invention.

Claims 2-7 depend either directly or indirectly from claim 1 and are allowable over the prior art for the same reasons as claim 1.

Claims 9-14 depend either directly or indirectly from claim 8 and are allowable over the prior art for the same reasons as claim 8.

Prior Art

The references cited but not relied upon are believed not to anticipate or make obvious Applicants' invention.

Summary

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

The Applicants believe that the subject application, as amended, is in condition for allowance. Such action is earnestly solicited by the Applicants.

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In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicant's attorney or agent at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection.

Respectfully submitted,

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